

Remarks

In the present application, claims 1-3, 7, 9-20, 25, 27-36 and 42-45 are pending. Claims 1-3, 7, 9-20, 25, 27-36 and 42-45 are rejected. Claims 4-6, 8, 21-24, 26, 37-41 and 46 have been previously canceled.

Amendment to the Claims

Claims 1-2, 18-20, 36 and 43-44 are amended with merely clarifying amendments. Support for these clarifying amendments may be found throughout the specification, for example, claims 9-10, 27-28 and 42 as previously presented.

Claims 9-10, 27-28 and 42 are canceled without prejudice or disclaimer.

No new matter is added.

Interview Summary

A telephone interview was held on August 24, 2010 at 2:00 pm between Ricardo Ochoa and Examiner Skowronek. During the interview, Claims 1, 9-10, 19, 27-28 and 43 were discussed. The Examiner highlighted that claims 9-10 and 27-28 were not rejected on the bases of prior art and that incorporating the subject matter of these claims into the independent claim, for example, by using Markush-type claim language, may help advance the prosecution of the claims.

No agreement was reached.

Objections to the Claims

The Examiner has objected to claim 1 because of informalities. The Applicants assert that this claim, as presently presented, overcomes this objection and respectfully requests the Examiner withdraw the objection to claim 1.

Claim Rejection - 35 U.S.C. § 112

The Examiner has rejected claims 1-3, 7-20, 25-36 and 42-45 under 35 U.S.C. § 112, second paragraph as being indefinite. The Applicants assert that these claims, as presently presented, overcome these objections and respectfully request the Examiner withdraw the objections to claims 1-3, 7-20, 25-36 and 42-45.

Claim Rejection - 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-3, 7, 11-17, 19-20, 25 and 29-35 as being unpatentable under 35 U.S.C. § 103(a) over Allen et al. ("The Automatic Generation of Keywords from Chemical Compound Names: Preparation of a Permuted Name Index with KWIC Layout"), herein Allen, in view of Brecher (U.S. Patent No. 7,054,754), herein Brecher, in view of Singh et al. ("Text Influenced Molecular Indexing (TIMI): A Literature Database Mining Approach that Handles Text and Chemistry"), herein Singh, in view of Moore et al. (U.S. Patent No. 5,577,239), herein Moore, in view of Hull et al. (U.S. Patent Publication No. 2002/0087508), herein Hull, in view of Cardinali ("Productivity improvements through the use of graphic user interfaces"), herein Cardinali, in view of Vander Stouw et al. ("Automated Conversion of Chemical Substance Names to Atom-Bond Connection Tables"), herein Vander Stouw, in view of Drefahl et al. ("Similarity-Based Search and Evaluation of Environmentally Relevant Properties for Organic Compounds in Combination with the Group Contribution Approach"), herein Drefahl, in view of Murray-Rust et al. ("Development of chemical markup language (CML) as a system for handling complex chemical content"), herein Murray-Rust; claims 18 and 36 as being unpatentable under 35 U.S.C. § 103(a) over Allen in view of Brecher in view of Singh in view of Moore in view of Hull in view of Cardinali in view of Vander Stouw in view of Drefahl in view of Murray-Rust and further in view of Kemp et al. ("Extraction of Information from the Text of Chemical Patents. 1. Identification of Specific Chemical Names"), herein Kemp; and claims 43-45 as being unpatentable under 35 U.S.C. § 103(a) over Allen in view of Brecher in view of Singh in view of Moore in view of Hull in view of Cardinali in view of Vander Stouw in view of Drefahl in view of Murray-Rust and further in view of Shivaratri et al. ("Load Distributing for Locally Distributed Systems"), herein Shivaratri. The Applicant includes the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully requests a favorable reconsideration of claims 1-3, 7, 11-20, 25, 29-36 and 43-45.

These rejections are respectfully disagreed with, and are traversed below.

It is well established law that in order for an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case for obviousness. Thus, as interpreted by the Courts, the Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that in accordance with *In re Lee*, the prior art must contain a suggestion, teaching, or motivation for one of ordinary skill in the art to modify a reference or combine references; and that the proposed modification must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made¹.

Regarding claim 1, as presently presented, recites subject matter previously recited in claims 9 and 10. As claims 9 and 10 are not rejected as being obvious in view of the cited prior art, claim 1 should now be allowable over the prior art.

For example, the Applicants submit that, as cited, Allen refers to syntax analysis using locations of characters and a character position in a name (see Allen page 13). Moreover, the Applicants note that Allen discloses "Syntax analysis is performed by reference to input lists of common chemical prefixes, suffixes, derivative names, and a list of element-name roots," (see Allen page 9 column 1). Therefore, Allen does not disclose or suggest "where said plurality of dictionaries consists of the dictionary of common chemical prefixes and the dictionary of common chemical suffixes" as previously recited in claim 9.

For at least this reason, claim 1 is in condition for allowance.

As claims 19 and 43 recite similar language to that discussed above with reference to claim 1; claims 19 and 43 are likewise in condition for allowance. Claims 2-3, 7, 11-18, 20, 25, 29-36 and 44-45 depend upon claims 1, 19 and 43. For at least this reason, they are likewise in condition for allowance.

In light of the discussion above, the Applicant respectfully asserts that a prima facie case for obviousness was not presented as required by the court in *In re Lee*. As such, the

¹ *In Re Fine*, 5 U.S.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Agmen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996); *In Re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

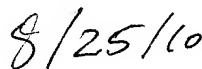
Applicant respectfully requests that the Examiner reconsider and withdraw these rejections to claims 1-3, 7, 11-20, 25, 29-36 and 43-45.

For the foregoing reasons, the Applicant believes that each and every issue raised by the Examiner has been adequately addressed and that this application is in condition for allowance. As such, early and favorable action is respectfully solicited.

Respectfully submitted:



Ricardo Ochoa



Date

Reg. No.: 61,545

Customer No.: 48,237

HARRINGTON AND SMITH, ATTORNEYS AT LAW, LLC

4 Research Drive

Shelton, CT 06484-6212

Telephone: (203) 925-9400 x24

Facsimile: (203) 944-0245

Email: ROchoa@HSPatent.com